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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,078	02/27/2002	Anthony J. Baerlocher	0112300/747	2836

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EXAMINER

CAPRON, AARON J

ART UNIT PAPER NUMBER

3714

DATE MAILED: 01/26/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/086,078

Applicant(s)

BAERLOCHER ET AL.

Examiner

Aaron J. Capron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 5. 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-18, 21-23 and 25-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Punch-a-Bunch/The Punch Board (hereafter "Punch Board").

Punch Board discloses a plurality of player selections; a plurality of offers associated with the selections; at least one display device for displaying the selections and offers to a player; a number of player picks of the selections; randomly associate the offers with the selections; enable the player to select the number of player picks of the selections; sequentially display each offer associated with each selection picked by the player to the player and enable the player to sequentially accept or reject each displayed offer until the player accepts the displayed offer or until the offer associated with all of the selections picked by the player are displayed to the player; and provide the player the displayed offer which is accepted by the player or if not displayed offer is accepted by the player, provide the player the last displayed offer (page 1), but does not disclose the game is run by a processor on the gaming machine. However, it is notoriously well known within the art of gaming machines to incorporate the features of a game show onto a gaming machine in order to attract people who like to watch the game show. One would be motivated to combine the references in order to attract people who like to watch the

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game show. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the a gaming machine having a game show type, as disclosed by Punch Board, in order to attract people who like to watch the game show.

Referring to claim 2-3, Punch Board discloses the plurality of offers are randomly selected from at least one pool of offers or a predetermined range of offer amounts (page 1).

Referring to claims 6-7, Punch Board discloses a gaming machine with a punchboard type of game, but does not specifically disclose revealing any of the other offers behind the unselected locations on the grid. However, it is notoriously well known within the art of electronic punchboard gaming machines to reveal all awards (offers) behind the locations on the grid in order to allow the player to verify the winning and/or losing outcomes on the grid. One would be motivated to provide the revealed outcomes of the whole grid to the player in order to entice the player to play the game longer to win the big prize. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the revealed outcomes of the whole grid to the player into the gaming machine of Punch Board in order to entice the player to play the game longer to win the big prize.

Referring to claim 8, Punch Board discloses the offers are associated with each picked selection are sequentially displayed in the order picked by the player.

Referring to claims 9-10, Punch Board discloses the selection are sequentially displayed by the order picked by the player, but do not disclose being in reverse order or a random order. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to be able to display the offers in any order to allow the player the control to affect the offer outcome. One would be motivated to display the offer in any order to allow the player the

control to affect the offer outcome. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to display the offers in any order to allow the player the control to affect the offer outcome.

Referring to claims 11-16, Punch Board discloses a second chance slip that allows a player to punch another hole and the two slips are added together (page 1, third paragraph).

Referring to claim 17, Punch Board discloses means for determining the number of player picks of the selections. Punch Board discloses the ability to receive an additional pick if a selection is made on the Punch Board that states that there is a Second Chance (Page 1, third paragraph).

Referring to claims 18, Punch Board discloses a plurality of player selectable masked symbols (selections on the Punch Board) and player picks associated with the selections on the Punch Board, wherein the number of player picks of the selections is at least based on the picks associated with one of the masked selections picked by the player. If a player gets a "Second Chance" slip the number of player selections will increment.

Claims 21-23 and 25-31 correspond in scope to a gaming device set forth for use of the gaming device listed in the claims above and are encompassed by use as set forth in the rejection above. Referring to claim 21, Punch Board discloses that the award is provided to a player after the player picks a plurality of selections.

Claims 32-37 correspond in scope to a gaming device set forth for use of the gaming device listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 38-43 correspond in scope to a gaming device set forth for use of the gaming device listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 44-45 correspond in scope to a gaming device set forth for use of the gaming device listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 46-48 correspond in scope to a gaming method set forth for use of the gaming device listed in the claims above and are encompassed by use as set forth in the rejection above. The Examiner views a player initiating play at a gaming machine as triggering a game. The number of player picks in the game Punch Board is determined by a sub-game.

Referring to claims 49-51, Punch Board as a gaming machine is disclosed above, but does not disclose that is provided over a data network, such as the Internet. However, it is notoriously well known in the art to provide casino games over the Internet in order to attract players that cannot physically travel to a casino. One would be motivated to provide the casino game Punch Board over the Internet in order to attract players that cannot physically travel to a casino. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a casino game onto the Internet in order to attract players that cannot physically travel to a casino.

Claims 52-55 correspond in scope to a gaming method set forth for use of the gaming method and device listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 4-5, 24 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Punch Board in view of Mayeroff (U.S. Patent No. 6,231,442).

Punch Board discloses a punchboard gaming machine having a number of player picks dependent, but does not disclose how the player picks are determined with respect to a gaming

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machine. However, Mayeroff discloses a gaming machine having a punchboard bonus game triggered by a base game wherein the number of player picks in the bonus game is dependent upon the random outcome of indices appearing on a pay line or by a predetermined number of coins that a player inputs into the base game of the gaming machine (3:50-56). One would be motivated to provide Mayeroff's gaming machine having the bonus game's number of picks being determined by a base game into the gaming machine of Punch Board disclosed above in order to encourage player to play more pay lines since the player would receive more chances at the bonus game based upon the amount the player puts into the machine (3:57-64). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a punchboard bonus game number of picks being determined by the base game, as disclosed in Mayeroff, into the gaming machine of Punch Board in order to encourage players to play more pay lines.

Claims 17-20, 30-31, 35-37, 41-43 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Punch Board in view of Mayeroff as applied to claims 4-5, 24 and 47 above, and further in view of Walker et al. (U.S. Patent No. 6,174,235; hereafter "Walker"), wherein the masked symbols are not the Punch Board selections.

Punchboard in view of Mayeroff discloses a gaming machine having a base game that initiates the bonus Punch Board game; wherein a combination of symbols in the base game can determine the number of player selections in the bonus game (3:50-56), but does not disclose that each masked symbols are associated with a plurality of picks. However, Walker discloses a gaming machine wherein the typical slot reels are altered in a manner to form a punchboard type

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of game that take a combination of symbols to form an outcome (2:56-3:15) that allows a player an illusion of control over the gaming machine (2:49-50). One would be motivated to combine the references in order to give the player an illusion of control over the gaming machine of Punch Board and Mayeroff. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a punchboard type of game in place of a slot reel game, as disclosed by Walker into the gaming machine of Punchboard and Mayeroff in order to give the player an illusion of control.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ajc

JOHN M. NOTALING, II  
PRIMARY EXAMINER

